

## REMARKS

The following remarks and the above amendments are submitted to address all issues in this case, and to put this case in condition for allowance.

With regard to the amendments, Applicant amends the claims in this case solely to better define the subject matter of the present invention. No new matter is added in these amendments. The new claims are supported by disclosure in the specification and by the figures. After the above amendment, claims 24-40 are pending, claims 24, 31, and 33 are independent

Applicant has studied the Office Action mailed January 6, 2005 and respectfully traverses. Applicant submits the following remarks to point out the distinctions between the instant claims and the cited art.

### **35 U.S.C. §102 and §103**

#### **Terauds and Potts**

The Examiner rejected Claim 24 of the instant application under 35 U.S.C. §102 as being anticipated by Terauds (4,563,001) and claims 24-27 and 31-32 as being anticipated by Potts (4,708,338). Applicant respectfully traverses the rejection on the grounds that the references do not show a first arm, disposed to move in a first arcuate path in a substantially vertical plane about said first point; [and] a second arm disposed to move in a second arcuate path in the same substantially vertical plane about said second point as required by independent claims 24, 31, and 33 as amended.

The Examiner has not indicated, and neither Potts nor Terauds show, the first arm and second arm moving in the same substantially vertical plane. Instead, both Potts and Terauds show two arms moving in different planes. Specifically, these references show the arms moving

in parallel planes. The current claims of the instant case require that the second arm move in the same plane as the first arm. Applicant asserts this was also the case with the claims prior to amendment since the plane of the second arm referred back to the plane of the first arm, however, in order to clarify the point, the independent claims have been amended to specifically reference that the planes are the same.

It would be impossible for the devices of Potts or Terauds to operate with the arms in the same plane, as the feet of the user would hit each other and the exercise devices of the references would not function.

Applicant further asserts that with regards to claims 31 and 32 the references clearly do not show a side-to-side stepping motion which the Examiner asserts is implicit. The exercise of the references is clearly a side-by-side stepping motion, not a side-to-side motion and such side-to-side motion is nowhere contemplated, or even believed possible, with the machines of the references.

### **Devlin**

The Examiner rejected Claims 24, 27-29, 31 and 32 as anticipated by Devlin (5,807,210) and claim 30 as obvious in light of Devlin. Applicant respectfully traverses on the grounds that Devlin does not show “means for providing resistance that only provides resistance to the motion of said first foot pad when said first foot pad is moving in said first arcuate path towards said base and said means for providing resistance only provides resistance to the motion of said second foot pad when said second foot pad is moving in said second arcuate path towards said base,” as required by amended claim 24. Devlin further does not show “performing a side-to-side stepping motion by pushing down on said first foot pad and said second foot pad in

sequence and having said side-to-side stepping motion be resisted by said exercise machine” as required by claim 31. Devlin also does not show a first and second arm members rotatable about independent points as discussed in all the independent claims 24, 31, and 33.

With regards to amended claim 24, the claim has been amended to include the limitations of claim 25. As claim 25 was not rejected by the Examiner in light of Devlin, amended claim 24 should be considered allowable in light of Devlin. Devlin does not show a means for providing resistance that only provides resistance on a downstroke motion.

With regards to claim 31, the Examiner simply states that the method of exercise inherently follows from the form (structure) of Devlin. Applicant respectfully traverses as Devlin specifically provides for a different exercise for his machine and in fact distinguishes a stepping motion exercise.

In order for an operation to be inherent, “the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference. . . inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” MPEP §2112(IV) citing *In re Robertson*, 169 F.3d 643,745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Further ““in relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.”” MPEP §2112(IV) citing *Ex Parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) [emphasis in original].

The device of Devlin is designed to provide for a balancing type exercise, the resistance of Devlin is not used to provide resistance to a side-to-side stepping exercise, but instead to make

balancing on the machine easier. Devlin, in fact, repeatedly states that resistance is unnecessary in the preferred operation. See column 4 line 62 to column 5, line 53.

During this discussion, Devlin also specifically states that the operation of his machine should be distinguished from devices using a stepping motion. “Known stepper exercisers have the function of providing resistance to movement of their foot pedals. . . . Such known steppers provide substantial resistance to movement of the pedals. For example, with known steppers on a user placing all their weight on one foot pedal, the pedal is expected to descend slowly with its movement resisted and dampened. . . . However, the exerciser of the present invention is preferably for use in a manner that little or no resistance is provided to vertical movement of the foot pedals.” (Col. 5, lines, 4-18)

Devlin, therefore, does not inherently describe the method of exercise of claim 31, as Devlin does not indicate that a side-to-side stepping exercise can be performed on his machine and specifically discloses using the machine for an exercise expressly differentiated from a stepping exercise. A side-to-side stepping exercise therefore cannot necessarily flow from the design of the machine of Devlin, as Devlin itself expressly states that the machine is preferred to be used in a different type of exercise and effectively discourages operation of the machine in a stepping exercise.

In Devlin, the user is intended to operate the machine in a manner where a stepping motion is discouraged as the user exercises by balancing in a neutral (or other) position and twisting his body (See e.g. FIGS 6-12 of Devlin and the associated discussion). As the method of exercising of claim 31 does not necessarily flow from the disclosure of Devlin, and Devlin specifically distinguishes stepping exercises from the operation of his machine, it is clear that Devlin cannot inherently disclose the method of exercising of claim 31.

With regards to all the independent claims 24, 31, and 33, Devlin does not show a first and second arm member rotatable about independent points. The Examiner, based on the listed rejection of claim 29 apparently has interpreted Devlin reference number 24, the “primary lever” (Col. 3, Line 49) as the first and second arms of the present claims 24, 31, and 33. Further, the Examiner indicated that the first and second link members of the instant claims are shown by Devlin reference number 28, the “secondary pivot lever” (Col. 3, Lines 24 and 25) in rejection of dependent claim 29. Without admission that this interpretation is accurate, under this interpretation Devlin expressly shows that the first and second arm must rotate around the same point as they are different portions of the same piece (See Devlin FIG. 2 and associated discussion, both halves of the primary lever 24 rotate about the axle member 20). Therefore, the first and second arm cannot rotate about independent points as required by the independent claims 24, 31, and 33 as both portions of the primary lever of Devlin necessarily rotate about the same point.

If one was to instead consider, simply for argument, that the first arm of the instant claims corresponds to Devlin component 24 while the second arm of the instant claims corresponded to Devlin component 28 (an interpretation that Applicant does not make admission is accurate and which the Examiner has not asserted), this would provide for independent rotational points for the two arms. However, there is clearly no component which could be described as a first or second link member as required by independent claim 33 and dependent claim 29.

### **Double Patenting**

Without admission as to the correctness of the double patenting rejection, Applicant includes herewith a Terminal Disclaimer which is believed to obviate the double patenting rejection.

### **Conclusion**

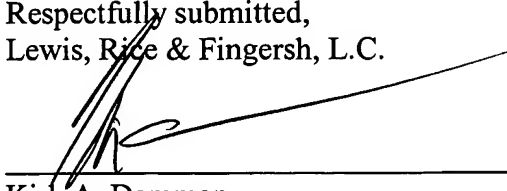
In light of the above remarks, Applicant believes there are no further issues regarding the patentability of claims 24-40 and respectfully requests the Examiner withdraw his rejections and allow all pending claims so that this case can pass on to issue.

Applicant includes herewith a petition for a 2 month extension of time and the associated petition fee, and the fee for filing of a terminal disclaimer. Applicant believes no additional fees are due in conjunction with this filing, however, the Commissioner is authorized to credit any overpayment or charge any deficiencies necessary for entering this amendment, including any claims fees and/or extension fees to/from our **Deposit Account No. 50-0975**.

If any questions remain, Applicant respectfully requests a telephone call to the below-signed attorney at (314) 444-7783.

Respectfully submitted,  
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